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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Slater

Serial Nos. 78344449 and 78344467

Robert C. Baker and Elvera E.S. Baker of R.C. Baker & Associated, Inc. for applicant.

Sharon A. Meier, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Quinn, Hairston and Zervas, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Applications were filed by James J. Slater to register the marks THE LAKESHORE GUY and LAKESHORE PLUS for "real estate services, namely real estate agency services for sellers and buyers of real estate."¹

The trademark examining attorney refused registration in each application under Section 2(d) of the Trademark Act on the ground that applicant's marks, when used in

¹ Application Serial Nos. 78344449 and 78344467, respectively. Both applications were filed on December 22, 2003. Both applications allege first use anywhere on August 31, 2001, and first use in commerce on February 28, 2002.

connection with applicant's services, so resemble the previously registered mark LAKESHORE INVESTMENT CORPORATION ("INVESTMENT CORPORATION" disclaimed) for "real estate and property management and leasing services"² as to be likely to cause confusion.

When the refusals were made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

In view of the common questions of law and fact that are involved in these two applications, and in the interests of judicial economy, we have consolidated the applications for purposes of final decision.³ Thus, we have issued this single opinion.

Applicant, in arguing against the refusal to register, contends that its marks and the cited mark are different in sound, appearance, connotation and commercial impression. According to applicant, the term "Lakeshore" is commonly used in the realty field and, thus, consumers will distinguish the marks based on other elements which, in the involved marks, are different. As to the services, applicant claims that property management and leasing

² Registration No. 2368785, issued July 18, 2000.

³ Applicant, in its reply brief, suggested "it may be that the Board would like to consider this appeal with Applicant's concurrent appeal." (Reply Brief, p. 1).

services pertain to commercial properties, whereas real estate buying and selling services pertain to home buying and selling, and that the trade channels for each are different. According to applicant, given the large amounts of money involved in real estate transactions, customers will be deliberate in their purchasing decisions. In support of its arguments, applicant submitted numerous exhibits retrieved from the Internet showing uses of "Lakeshore" in connection with a variety of real estate services. Applicant also made of record printouts of searches of "lakeshore property management" and "lakeshore realty" using the search engine provided at www.metacrawler.com.

The examining attorney maintains that the marks are similar in that applicant's marks and the cited mark are dominated by the identical term "LAKESHORE." The examining attorney is not convinced that the term "Lakeshore" is weak, pointing to the absence in the record of third-party registrations of LAKESHORE marks covering real estate services. According to the examining attorney, the involved services belong to the same general category of services, appeal to the same consumers, and are rendered in similar trade channels. In support of her contention that the services are related, the examining attorney introduced

third-party registrations which individually cover both types of services involved herein,⁴ as well as excerpts from websites showing that the same entities offer real estate agency services, and real estate property management and leasing services. Consumers for these types of services are accustomed to seeing these services provided by the same entity under the same mark, the examining attorney contends, and, thus, any sophistication of consumers does not necessarily mean that they will not be confused in their purchasing decisions.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In*

⁴ Applicant's objection to this evidence is misplaced. As we subsequently indicate in this decision, with supporting case law, this type of evidence has relevance to the likelihood of confusion determination. Accordingly, applicant's objection is overruled, and this evidence has been considered.

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re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Turning first to the marks, we must compare registrant's cited mark LAKESHORE INVESTMENT CORPORATION with each of applicant's marks THE LAKESHORE GUY and LAKESHORE PLUS in terms of appearance, sound, meaning and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). In comparing the marks, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the services offered under the respective marks is likely to result. Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper, for rational reasons, to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applicant argues at length about the differences between its marks and registrant's mark. As to appearance, applicant contends that each of its marks is "crisp,

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[having] only four [or three] syllables, and has the flair of being an ordinary non-sophisticated introduction that is down to earth," whereas registrant's mark has "nine ponderous syllables suggesting formality and importance." With regard to sound, applicant asserts that each of its marks "sounds informal and friendly and ready to serve, whereas registrant's projects total formality and awesome power." With respect to connotation, applicant posits that each of its marks "invites approach and implies a favorable reception with nothing to fear, whereas registrant's mark has the connotation of the tremendous power and strength of a financial giant to be approached with awe." Insofar as commercial impression is concerned, applicant states that each of its marks "has a definite twist toward informality and friendliness, with a refreshing promise of swift and agile service -- whereas registrant's mark with its nine ponderous syllables and strong impression of 'money leading to money' (re 'investment') gives the commercial impression of extreme formality and supremely ponderous action at the convenience of registrant, not the customer." (Brief, p. 4).

Although there are specific differences between registrant's mark LAKESHORE INVESTMENT CORPORATION and applicant's marks THE LAKESHORE GUY and LAKESHORE PLUS, we

find that, on balance, the similarities outweigh the differences.

In comparing the marks, we first note that each of the involved marks is dominated by the identical term LAKESHORE. Although registrant's mark includes the additional words INVESTMENT CORPORATION, these merely descriptive and, thus, disclaimed words are clearly subordinate to LAKESHORE. Further, consumers are often known to use shortened forms of names, and it is highly likely that registrant and its mark will be referred to as "Lakeshore." Cf. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978)[Rich, J., concurring: "the users of language have a universal habit of shortening full names--from haste or laziness or just economy of words"]. Likewise, the term LAKESHORE dominates over the words THE and GUY in one of applicant's marks, and over PLUS in the other mark. The portion of each of applicant's marks most likely to be remembered by consumers and used in calling for the services is LAKESHORE. Thus, the dominant portions of the involved marks are identical. Although the marks are dominated by the identical term, we must, of course, consider the marks in their entirety. In doing so, we find that the marks are similar in sound and appearance.

With respect to meaning, we recognize that the words added to the identical term LAKESHORE in each of the marks gives each mark a somewhat different connotation. Nonetheless, we find that the similarities in sound and appearance outweigh the differences in connotation.

Further, when the registrant's mark and each of applicant's marks are considered in their entirety, the marks engender sufficiently similar overall commercial impressions so that, if similar services were offered thereunder, confusion would be likely to occur among consumers. That is, it is reasonable to conclude that consumers familiar with registrant's mark will view THE LAKESHORE GUY as identifying services from the "guy at Lakeshore (Investment Corporation)," and LAKESHORE PLUS as identifying enhanced or special services originating from registrant. Again, the fact that each of the involved marks is dominated by the identical term LAKESHORE plays a significant role in our analysis.

Applicant, in contending that the marks are not confusingly similar, asserts that the term "Lakeshore" is so widely used in the real estate field that the commonality of the term is an insufficient basis upon which to find that the marks are confusingly similar. Applicant specifically argues as follows (Brief, p. 13):

Faced with a slew of "lakeshore" usages in the actual marketplace of relevant customers and potential customers, a customer or potential customer is not likely to conclude that the geographic "lakeshore" alone identifies and distinguishes the services of one entity from all others in the realty area. The relevant customers and potential customers have too much at stake to be careless, and the cyberspace world has also conditioned customers to watch for distinguishing features apart from what they well know is a geographic common term (i.e., "lakeshore") when it comes to any realty matters.

In support of this contention regarding the du Pont factor involving the number and nature of similar marks in use in connection with similar services in the real estate field, applicant submitted over thirty examples of uses of "Lakeshore" in third-party websites and on-line directories. In addition, applicant introduced the results of Internet searches of the terms "lakeshore property management" (twenty-seven hits) and "lakeshore realty" (fifty-seven hits).

Applicant's evidence does not compel a different result in determining the likelihood of confusion. As the Federal Circuit has stated, "[t]he probative value of third-party trademarks depends entirely upon their usage." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee*, supra at 1693. At best, the uses comprise evidence

that the consuming public could potentially be cognizant of third-party use of the term "Lakeshore." The record, however, is devoid of any evidence of the consuming public's awareness of such uses; nor is there any information as to, for example, how long the websites have been operational or the extent of public exposure to the sites. Where the "record includes no evidence about the extent of [third-party] uses...[t]he probative value of this evidence is thus minimal." *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1561 (Fed. Cir. 2001). Moreover, the evidence of these uses tend to indicate that the various third-party real estate operations are local in nature, as is undoubtedly the case with many real estate and property management entities.⁵ See *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125, 1131 (TTAB 1995). In view of the above, we cannot conclude that there is such significant third-party use of "Lakeshore" marks or trade names that consumers are likely to make a distinction between registrant's mark and applicant's mark if these marks were used in connection with similar services.

⁵ In this connection, we note Mr. Slater's website that indicates he is "one of the area's" top real estate agents dealing in properties around Lake Prior in Minnesota.

We next turn to the du Pont factor regarding the similarity or dissimilarity of the involved services. In comparing the services, it is not necessary that they be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the services originate from or are in some way associated with the same source. In *re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). The issue of likelihood of confusion must be determined on the basis of the goods and/or services as set forth in the applications and the cited registration. In *re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); and *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987).

The record supports a finding that real estate agency services for sellers and buyers of real estate, on the one hand, and real estate and property management and leasing services, on the other, are closely related. An individual may buy real estate for investment, first using real estate

agency services for the purchase and subsequently using property management and leasing services in connection with the purchased real estate. Lest there be any doubt on the relatedness of the involved services, the examining attorney introduced several third-party websites showing that a single real estate agency or agent will offer a variety of real estate services, including both types of services involved herein. The evidence establishes that, in the real estate field, a common source will offer both real estate agency services for buyers and sellers of real estate, and real estate and property management and leasing services.

The examining attorney also made of record several use-based third-party registrations in an attempt to show that services of the types identified in the applications and in the cited registration may be sold under a single mark by a single source. Third-party registrations which individually cover a number of different services and which are based on use in commerce are probative to the extent that they suggest that the listed services are of a type which may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993). Here, the registrations show adoption of the same mark by the same entity for, inter alia, various real estate services, such

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as real estate agency services for the buying and selling of real estate, as well as for real estate property management and leasing services. In sum, registrant's and applicant's services are clearly related, and would be offered in the same channels of trade (e.g., real estate agencies) and be bought by the same classes of purchasers.

Applicant asserts that real estate agency services pertain to residential properties while property management and leasing services pertain to commercial properties. Applicant also argues that real estate transactions involve a deliberate decision, and that purchasers of real estate services are sophisticated and will distinguish source based on the differences between the involved marks and the services rendered thereunder. The involved identifications of services, however, do not include any limitations. Accordingly, we must presume, therefore, that the identifications encompass all services of the type described, and that the identified services move in all channels of trade and to all classes of purchasers that would be normal for such services. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). Although real estate may involve a sophisticated purchase and a significant amount of money, this is not necessarily so and, moreover, neither applicant's nor registrant's services are limited as to the

price of the real estate or the type of property involved (residential versus commercial). We must presume, therefore, that the services are rendered to not only sophisticated purchasers, but also to ordinary purchasers who may be making their first purchase of real estate, whether for a residence or an investment. That is to say, the types of real estate services involved herein are presumed to be offered to a wide range of consumers, many of whom are not likely to be sophisticated in the real estate field, much less capable of distinguishing between the sources of applicant's and registrant's related services rendered under their similar marks. In finding likelihood of confusion between the marks, we have kept in mind that, at least with respect to ordinary consumers, due to the normal fallibility of human memory over time, these consumers retain a general rather than a specific impression of trademarks encountered in the marketplace. In *re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986). Further, to the extent that some purchasers may be knowledgeable in the field of real estate, this does not necessarily mean that they are immune from source confusion. In *re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

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We conclude that consumers familiar with registrant's real estate property management and leasing services offered under the mark LAKESHORE INVESTMENT CORPORATION would be likely to believe, upon encountering applicant's marks THE LAKESHORE GUY and LAKESHORE PLUS for real estate services, namely, real estate agency services for sellers and buyers of real estate, that the services originate from or are somehow associated with or sponsored by the same source.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed in each application.